REMARKS

This Response is to the final Office Action mailed on February 22, 2006 and the personal interviews granted courteously to Applicant's representatives on April 25, 2006 and June 8, 2006. A Request for Continued Examination is submitted herewith.

I. STATUS OF THE CLAIMS

Claims 1 to 65 (as renumbered) were originally filed and pending in this application. It should be noted that the Office Action and original application indicated that claims 1 to 61 were filed and pending. The original claims were inadvertently misnumbered after claim 32, and indicated that the next claim was claim 29 (a duplicate) instead of claim 33.

By this response, claims 1 to 8, 18 to 31 and 61 to 65 (as renumbered) have been canceled without prejudice or disclaimer. Claims 9, 32, 38 and 55 (as renumbered) have been amended. Please charge Deposit Account No. 02-1818 for a One Month Extension of Time, a Request for Continued Examination and any other fees deemed owed during the pendency of this application, excluding the issue fee.

II. CLAIMS REJECTIONS

The Office Action provisionally rejects claims 1, 5, 8 and 28 under 35 U.S.C. §101 as being potentially double patented over claims 24, 25, 27 and 28 of co-pending U.S. patent application serial No. 10/624,150. The Office Action rejects claim 1 to 61, and presumably renumber claims 1 to 65, under 35 U.S.C. §102(f) as having been invented by another. The Office Action further rejects claims 1 to 12, 15 to 21, 24 to 26, 28, 29, 32 to 37, 40 to 45, 48 to 55, 57, 58 and 61 (without renumbering) as anticipated by Scholarly Review ASIAO Journal article authored by Roberts et al. ("the *Roberts Article*"); and claims 13, 14, 22, 23, 31, 38, 39, 46, 47, 56 and 60 (without renumbering) as obvious over the *Roberts Article* in view of U.S. Patent No. 5,631,025 to Shockley et al. ("*Shockley*").

A. PROVISIONAL DOUBLE PATENTING REJECTION

Applicant respectfully submits that the claims as presently presented render the provisional rejection of claims 1, 5, 8, and 28 over co-pending U.S. patent application serial No. 10/624,150 moot and that the rejection should be withdrawn.

B. CLAIM REJECTIONS UNDER 35 U.S.C. §102(f)

Applicant respectfully submits that the claims as presently presented render the rejection of claims 1 to 65 (as renumbered) under 35 U.S.C. 102(f) moot and that the rejection should be withdrawn.

C. CLAIM REJECTIONS UNDER 35 U.S.C. §102(b)

Applicant respectfully traverses the rejection of claims 1 to 12, 15 to 21, 24 to 26, 28, 29, 32 to 37, 40 to 45, 48 to 55, 57, 58 and 61 (without renumbering) as anticipated[1] by the *Roberts Article* in light of claims 9, 28, 38 and 55 (as renumbered) and their dependents as presently presented. As agreed upon in the June interview and reflected in its Interview Summary, the art of record does not teach a pump (cycler or circulator), reservoir (container) and circuit (branching) shown in connection with Fig. 3. For at least these reasons, Applicant respectfully submits that the anticipation rejections of these claims should be withdrawn.

Regarding claim 45 (as renumbered), Applicant respectfully submits that no reference including the *Roberts Article* teaches or suggests the step of draining the fluid circuit of fluid at an effective rate to compensate for an increase in fluid volume due to the second supply of the therapy fluid and the ultrafiltrate. For at least this reason, Applicant respectfully submits that the anticipation rejection of this claims should be withdrawn.

D. CLAIM REJECTIONS UNDER 35 U.S.C. §103

Applicant respectfully traverses the rejections of claims 13, 14, 22, 23, 27, 30, 31, 38, 39, 46, 47, 50, 56, 59 and 60 (without renumbering) as obvious[2] over the

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[1] "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

[2] To establish a *prima facie* case of obviousness, three basic criteria must be met.:

(a) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

(b) Second, there must be a reasonable expectation of success.

(c) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See* MPEP §2143 - §2143.03 for decisions pertinent to each of these criteria.

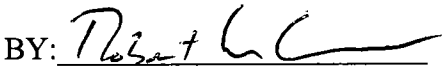
Roberts Article in view of *Shockley* or *Ash*. As agreed, none of the cited references, either alone or in combination, teaches or suggests the claims as presently presented for at least the reason that none teaches (i) a container connected fluidly to a cycler and branching off of the closed fluid loop or the step of branching a container off of the closed fluid path or (ii) communicating the container fluidly with a circulator of the dialysate so as to be able to selectively increase a volume capacity of the fluid circuit to compensate for an increase in fluid volume in the fluid circuit due to removal of the ultrafiltrate from the patient. For these reasons, Applicant respectfully submits that the obviousness rejections should be withdrawn.

III. CONCLUSION

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance and earnestly solicit reconsideration of same. If questions arise during the examination of this application, Applicant requests that the Examiner contact Applicant's representative at the information provided below.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY: 

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